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10/662,766	09/15/2003	Kenichi Ayukawa	1503.68346	1514

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GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER	
NGUYEN, THUY-VI THI	

ART UNIT	PAPER NUMBER
3689	

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12/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/662,766	AYUKAWA ET AL.	
	Examiner	Art Unit	
	THUY VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 August 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on 27, August, 2008, wherein:

Claims 1-9 have been amended;

Claim 8 has been withdrawn due to the response election/restriction on 01, May, 2008.

Claims 1-9 are currently pending;

Note : Claim 9 is has been amended and it is not an original claim as stated in the response from Applicant filed on 08/27/2008.

The amended claims 1 and 9 are as follow:

Amended claim 1: A ~~clothesmaking~~ clothesmaking kit shop in ~~which sewing can be experienced and~~ which sells ~~clothesmaking~~ clothesmaking kits and where the shop is configured and arranged to permit sewing to be experienced therein comprising:

a) a ~~clothesmaking~~ clothesmaking kit shelf storing the ~~clothesmaking~~ clothesmaking kit;

b) a sewing machine mounted on a stand; and

c) a replay device replaying a sewing method, ~~which~~ is recorded on a storage medium, which a customer watches to learn and experience sewing using the sewing machine and the clothesmaking kit.

Amended claim 9: ~~Clothesmaking~~ Clothesmaking kit selling facilities established to sell ~~clothesmaking~~ clothesmaking kits, comprising:

a) replay means for replaying a storage medium, which ~~records~~ has recorded thereon a sewing method for teaching a customer to sew;

b) sewing means for sewing, which is installed in a place where pictures replayed by the replay means can be watched so that the customer can learn and experience sewing using said sewing means and the clothesmaking kits; and

c) storage means for storing ~~clothesmaking~~ clothesmaking kits, including textiles to be made into an item of clothing, where said textiles are used by the sewing means when sewing.

Note 2: for convenience, letters (a)-(c) are added to the beginning of each step.

Note 3: claims 1 and 9 are an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)*. Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e. recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

1) therefore with claim 1, the phrase "*which sells clothesmaking kit and where the shop is configured and arranged to permit sewing to be experience; storing the clothesmaking kit; which a customer watches... to learn and experience sewing using the sewing machine and the clothesmaking kit*" is not a structure or functional element but appears to be a method step or manner in which a claimed apparatus is intended to be employed "*sells….*". Furthermore, the term "*to permit sewing….; watch to learn and experience sewing ….*" is an intended use and thus having no patentable weight.

2) similarly, claim 9, the amended limitation a) " *which has recorded thereon a sewing method for teaching a customer to sew....*; b)*…so that the customer can learn and experience sewing using said sewing means and the clothes making*; c)*… to be made into an item of clothing, where said textiles are used to by the sewing means when sewing*:" is not a structure or functional element but appears to be a method step or manner in which a claimed apparatus is intended to be employed "recorded…; installed …", and thus having no patentable weight.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims **1-4, 7 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al. (US 5,768,135) in view of Yoshida et al. (US. 6,024,037). Herein after is referred as Park and Yoshida.

Regarding claim 1, Park discloses clothesmaking kit shop in which sewing can be experienced and which sells clothesmaking kits, comprising:

Park discloses a clothesmaking kit shelf storing the clothesmaking kit or items for making clothes [...shelves 20 that contains the clothesmaking kit; i.e. textile such as garment or apparel, figure 1, col. 4, lines 49-62; col. 5, lines 30-32 and figure 1, shelves (20)];

However, Park does not disclose a sewing machine mounted on a stand, a replay device replaying a sewing method, which is recorded on a storage medium.

Yoshida discloses a sewing machine mounted on a stand [...figure 1]; and

a replay device replaying a sewing method, which is recorded on a storage medium [*...i.e. the sewing program is stored in a recording medium such as flexible disk, a CDROM, or IC card*; col. 9, lines 22-31; *control device (30) having the flexible disk drive unit (32; figures 1, 6-7)*].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Park with the retail store having a shelf storing the apparels for customer to select to include a sewing machine and a replay device with a storage medium for recording a sewing method as taught by Yoshida in order to improve the process of making apparels..

Regarding claim 2 Park discloses a textile shelf storing textiles [...shelves 20 that contains the clothesmaking kit; i.e. garment or apparel, figure 1, col. 4, lines 49-62];

Regarding claim 3, Yoshida discloses a shelf storing at least one of the sewing machine and storage medium [figure 1].

Regarding claim 4, Park discloses which sells textiles stored in the textile shelf [figures 1 and 7].

Regarding claim 7, Park discloses wherein said clothesmaking kit includes at least one of textiles; marking drawings and manuals on a sewing procedure [...figure 1].

Note: as for the phrase "....textiles *to be made into an item of clothing*", this is considered as a method step in an apparatus claim, therefore it has no patentable weight.

Regarding claim 9, Park discloses clothesmaking kit selling facilities established to sell clothesmaking kits, comprising:

storage means for storing clothesmaking kits including textiles used by the sewing means [...shelves 20 that contains the clothesmaking kit; i.e. garment or apparel, figure 1, col. 4, lines 49-62; col. 5, lines 30-32 and figure 1, shelves (20)];

However, Park does not disclose replay means for replaying a storage medium, which records a sewing method; sewing means for sewing, which is installed in a place where pictures replayed by the replay means can be watched;

Yoshida discloses replay means for replaying a storage medium, which records a sewing method [*...i.e. the sewing program is stored in a recording medium such as*

flexible disk, a CDROM, or IC card; col. 9, lines 22-31; *control device (30) having the flexible disk drive unit (32; figures 1, 3-4)*];

sewing means for sewing, which is installed in a place where pictures replayed by the replay means can be watched [...sewing machine (1), program (22) having an LCD (28); col. 3, lines 14-15; lines 54-57 and figures 1, 3].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide Park with the retail store having a shelf storing the apparels for customer to select to include a sewing machine and a replay device with a storage medium for recording a sewing method as taught by Yoshida in order to improve the process of making apparels.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park et al. (US 5,768,135) in view of Yoshida et al. (US. 6,024,037) and further in view of Hirata (US 5,771,826).

Regarding claims 5-6, the teaching of Park as modified by Yoshida is indicated above. Park as modified by Yoshida further discloses a clothesmaking kit shop [figures 1 and 4]. However, Park as modified by Yoshida does not disclose clothesmaking kit shop which sells the storage medium and sells the sewing machine.

Hirata discloses the selling the storage medium and sewing machine [...sells memory cards of sewing machine; col. 1, lines 33-39; lines 44-46].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the combination of Park with the clothesmaking kit shop having a sewing machine and a storage medium for recording the sewing to include the selling sewing machine and storage medium as taught by Hirata in order to provide the convenient for user when using this storage medium in a sewing machine as an instruction for making apparels.

Response to Arguments

6. Applicant's arguments with respect to above claims have been considered but are moot in view of the new claim interpretations as shown on the "Note 3" with respect to claim interpretation/limitations/patentable weight with respect to the apparatus claim above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information As for the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689